Office - Supreme Court,
FILED
JUL 15 195
CHARLES ELMORE CR
CL

3

IN THE

Supreme Court of the United States

OCTOBER TERM, 1952.

No. 118.

LANOLIN PLUS COSMETICS, INC., *Petitioner,*

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,

and

BOTANY MILLS, INC., *Respondents.*

On Petition for Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

BRIEF FOR THE RESPONDENT, BOTANY MILLS, INC. IN OPPOSITION

ALFONS B. LANDA,
RAYMOND C. CUSHWA,
1000 Vermont Avenue, N. W.,
Washington 5, D. C.

H. VON MALTITZ,
165 Broadway,
New York 6, New York,
Attorneys for Respondent,
BOTANY MILLS, INC.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

INDEX.

	Page
Opinions Below	1
Jurisdiction	1
Question Presented	2
Statute Involved	2
Statement	2
Argument	3
Conclusion	6

CITATIONS.

CASES:

McGraw Hill Pub. Co., Inc. v. *American Aviation Associates, Inc.*, 73 App. D. C. 131, 117 F. 2d 293 (1940) 5

Model Brassiere Co., Inc. v. *Bromley-Shepard Co., Inc.*, 49 F. 2d 482 (1931) 6

Morgan v. *Daniels*, 153 U. S. 120 (1894) 4

National Recreation Ass'n., Inc., In re, 181 F. 2d 221 (1950) 5

Safeway Stores, Inc. v. *Dunnell*, 172 F. 2d 649 (9th Cir. 1949) 4

United Shoe Machinery Corp. v. *Compo Shoe Machinery Corp.*, 56 F. 2d 292 (1932) 6

STATUTES:

Judicial Code, Sec. 240(a) 2

Revised Statutes, Sec. 4915 ..... 3, 4

Trade Mark Act of Feb. 20, 1905, Sec. 5 ..... 2, 3

IN THE

Supreme Court of the United States

OCTOBER TERM, 1952.

No. 118.

LANOLIN PLUS COSMETICS, INC., *Petitioner,*

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,

and

BOTANY MILLS, INC., *Respondents.*

On Petition for Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

---

BRIEF FOR THE RESPONDENT, BOTANY MILLS, INC. IN OPPOSITION

Opinions Below

The opinion of the District Court (R. 12-14) dismissing petitioner's complaint, has not been officially reported. The opinion of the United States Court of Appeals for the District of Columbia Circuit (R. 44) is reported at 196 F. 2d 591 (1952).

Jurisdiction

The judgment of the United States Court of Appeals was entered on April 17, 1952 (R. 46). The petition for writ of certiorari was filed on June 10, 1952, and it was served

on respondent, Botany Mills, Inc., on June 18, 1952. The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925.

Question Presented

The question presented is whether the notation LANOLIN PLUS is registrable as a trademark for cosmetics and soaps under the Trade-Mark Act of February 20, 1905.

Statute Involved

Section 5 of the Trade-Mark Act of 1905 (Act of February 20, 1905, c. 592, 33 Stat. 724; 15 U. S. C. § 85) provides in part that no trade-mark which consists . . .

> "merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, . . . shall be registered under the terms of this act;"

Statement

Petitioner sought registrations in the United States Patent Office of the notation LANOLIN PLUS under the Trade-Mark Act of 1905, as a trade-mark for face cream and related products, as well as for toilet soap and laundry soap. Exclusive rights to the word "lanolin" were disclaimed in both applications. Oppositions to these applications were filed by respondent, Botany Mills, Inc., based upon the ground that the notation LANOLIN PLUS was not registrable under the Act of 1905 in view of its completely descriptive character. It was alleged that Botany Mills, Inc. and others similarly situated would suffer injury in their business if so descriptive a notation as LANOLIN PLUS could be exclusively appropriated by a competitor in the cosmetic business. The Examiner of Interferences of the Patent Office sustained both Opposition No. 24,963, with regard to face cream, and Opposition No. 26,917, with regard to soap (R. 32 and 37). The Examiner held the notation

LANOLIN PLUS to be incapable of exclusive appropriation under Section 5 of the Act of 1905.

On appeal, the Commissioner of Patents sustained the Examiner's decisions on the same ground. (R. 33 and 40)

Petitioner thereupon brought this suit in the United States District Court for the District of Columbia, under Section 4915 of the Revised Statutes, as amended (35 U. S. C. § 63), asking that the respondent, the Commissioner of Patents, be directed to issue to petitioner certificates of registration of its trade-mark, which, the complaint alleged, respondent had refused. (R. 1) After a trial, the District Court dismissed the complaint (R. 12), finding as facts that petitioner's mark was "clearly descriptive" and, therefore, not entitled to registration. The District Court held that, notwithstanding the previous grant of certain similar trademark registrations to other parties the notation LANOLIN PLUS did not qualify for registration, and that the other registrations relied upon by petitioner could not "overcome the language of the statute". (R. 12)

The court below affirmed the judgment of the District Court in a *per curiam* decision. (R. 44) It emphasized that the fact that the Patent Office may have erred in earlier cases "does not mean it should err in this one". (R. 45) Consequently, the court below unanimously reached the conclusion that the decision of the District Court should be affirmed.

Argument

Petitioner's applications to register the notation LANOLIN PLUS under the Act of 1905 have now been rejected by four different tribunals without a single dissent and always on the identical statutory ground. This is probably the first time in the history of this Court that an applicant for registration of a trade-mark has gone so far as to invoke the "equal protection" clause of the Federal Constitution (Petition for Certiorari, p. 4) and the "due process" clause of the Constitution (ibid.), for the purpose of determining the simple statutory question whether the notation LANOLIN

PLUS is "descriptive" as applied to face cream and soap. That the determination of the registrability of a descriptive term does not involve a constitutional problem or any problem of a federal nature which should be settled by this Court, appears so obvious on its face as to require hardly any further discussion in this brief.

I. The proceeding under Revised Statutes 4915, which petitioner instituted after both the Examiner of Interferences and the Commissioner of Patents had rejected the notation LANOLIN PLUS as being clearly descriptive, is not in the nature of an appeal but is a *de novo* proceeding in the nature of an action to set aside a judgment. It is settled beyond dispute that in such a proceeding an administrative ruling should not be set aside, unless found to be clearly erroneous. As stated by this Court, in *Morgan* v. *Daniels*, 153 U. S. 120 (1894), a proceeding under R. S. 4915 in a patent or trade-mark case "is something more than a mere appeal". The Patent Office ruling will not be set aside, under the *Morgan* doctrine, unless upon the presentation of testimony "which in character and amount carries thorough conviction". The same basic principle was recently applied in *Safeway Stores, Inc.* v. *Dunnell*, 172 F. 2d 649 (9th Cir. 1949).

There is nothing in the record or in the petition for certiorari to indicate that the Patent Office tribunals, the District Court, and the Court of Appeals in its *per curiam* decision have all misconstrued the federal trade-mark statute by coming to the obviously correct and common-sense conclusion that the generic word "lanolin" cannot be converted into an exclusive trade-mark by adding the descriptive word "plus" thereto.

II. The argument submitted by the petitioner to this Court is in effect an accusation that the Patent Office tribunals, as well as both lower courts, have violated the 5th Amendment of the Constitution by refusing to continue an alleged erroneous practice of the past. Actually, there are

not more than about five or six previous "Plus" marks registered which correspond to the one now before the Court, such as, for instance, "VITAMIN-PLUS", "ASPIRIN-PLUS", and a few others. A superficial glance at the 129 so-called "plus" registrations submitted by petitioner to the trial court will show that the vast majority thereof disclose arbitrary features in addition to the word "-PLUS", which made the respective marks registrable under the Act of 1905.

Moreover, the Commissioner of Patents has frequently changed his position in connection with questions of descriptiveness or registrability. Sometimes he did so upon reconsideration, on his own initiative, and on other occasions he was compelled to do so by a mandate of an appellate tribunal. Suffice it to refer here to the recent case *In re National Recreation Ass'n., Inc.*, 181 F. 2d 221 (1950), in which the name "Playground" had been registered for a magazine under the Act of 1905, but upon lapsing was refused registration under the same Act on the ground that, under an Appellate Court decision which had meanwhile been rendered regarding the issue of descriptiveness (*McGraw Hill Pub. Co., Inc.* v. *American Aviation Associates, Inc.*, 73 App. D. C. 131, 117 F. 2d 293 (1940) involving the word "Aviation"), the word "Playground" should now be held to be descriptive and unregistrable under the Act of 1905. It remains for the petitioner in this case to characterize such change in administrative practice as "discrimination" and a "violation of the Fifth Amendment of the Constitution". This novel allegation is, we believe, sufficiently refuted by the fact that all tribunals below were unanimous in the conclusion that the issue of a few unduly liberal and incorrect trade-mark registrations did not create a "right" in any subsequent applicant to insist upon the continuation of the initial error.

III. Petitioner reiterates before this Court the contention that it was a "clear error of law" to hold respondent, Botany Mills, Inc., entitled to institute the opposition pro-

ceedings in the Patent Office since, in petitioner's opinion, Botany had failed to make any proper showing of injury or damage. It is said in this regard (Petition for Certiorari, p. 14) that respondent Botany Mills, Inc., had no right to oppose petitioner's applications "since it had and claimed to have no prior rights or rights of any kind to petitioner's trade-mark 'LANOLIN PLUS'." It is, of course, well settled, at least since the decisions of the Court of Customs and Patent Appeals in *United Shoe Machinery Corp.* v. *Compo Shoe Machinery Corp.*, 56 F. 2d 292 (1932) and *Model Brassiere Co.*, v. *Bromley-Shepard Co., Inc.*, 49 F. 2d 482 (1931), that someone who objects to a trade-mark registration on the basis of descriptiveness, is entitled to file opposition proceedings on the ground that his right freely to use such descriptive term would be hampered if a registration were to issue to a competitor.

Conclusion

The decision of the two courts below, as well as those by the Patent Office tribunals, are correct. No question of constitutional law or statutory construction is involved. The petition for a writ of certiorari should be denied.

Respectfully submitted,

ALFONS B. LANDA,
RAYMOND C. CUSHWA,
1000 Vermont Avenue, N. W.,
Washington 5, D. C.

H. VON MALTITZ,
165 Broadway,
New York 6, N. Y.,
Attorneys for Respondent,
BOTANY MILLS, INC.

July, 1952.